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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT PAPER NUMBER

2161

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/020,712	Applicant(s) PAINE ET AL.	
	Examiner Etienne P LeRoux	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 66-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/27/2006</u> | 6) <input type="checkbox"/> Other: _____ |

Claim Status:

Claims 66-84 are pending; claims 1-65 have been cancelled. Claims 66-84 are rejected as detailed below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 66-71 and 73-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,421,675 issued to Ryan et al (hereafter Ryan) in view of US Pat No 6,289,341 issued to Barney (hereafter Barney).

Claims 66, 79 and 80:

Ryan discloses::

- (a) obtaining a set of potential search terms for acceptance by a new information provider who is adding items to the database [keyword 52, Fig 2, col 5, line 13]
- (c) computing an estimated rating for the each potential search term for the new information provider [Crawler key-word list, col 7, line 63-col 8, line 5]
- (d) sorting the potential search terms according to the computed estimated ratings[
- (e) presenting to the new information provider on an output device the sorted potential search terms [Crawler key-word list, col 7, line 63-col 8, line 5]
- (f) receiving from the new information provider at an input device an indication of accepted search terms [Surfer keyword list col 8, lines 15-20]
- (g) repeating (b) through (e) until completion indication is received from the new information provider [successive surfer key-word lists, col 8, line 30]
- (h) storing the accepted search terms in the database for the new information provider upon receipt of the completion indicator [keyword table, 164, Fig 4, col 11, lines 20-40].

Ryan discloses the elements of the claimed invention as noted above but does not disclose (b) computing correlations between the potential search terms for the new information provider and search terms of other information providers stored in the database. Barney discloses (b) computing correlations between the potential search terms for the new information provider and search terms of other information providers stored in the database [col 5, lines 20-35]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ryan to include (b) computing correlations between the potential search terms for the new information provider and search terms of other information providers stored in the

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database as taught by Barney for the purpose of making a statistical comparison between the potential search terms and the database comprising keywords generated from existing websites.

Claims 67, 81 and 82:

The combination of Ryan and Barney discloses the elements of claim 66 as noted above and furthermore, Ryan discloses receiving from the new information provider a website uniform resource locator and spidering the website [col 7, lines 60-65] associated with the website URL [col 6, lines 35-30] to obtain search terms for the set of potential search terms.

Claim 68 and 83:

The combination of Ryan and Barney discloses the elements of claims 66 and 67 as noted above and furthermore, Ryan discloses receiving data from pages of the website, recording potential search terms from the data and determining a quality metric for each potential search term [Surfer keyword list col 8, lines 15-20]

Claim 69

The combination of Ryan and Barney discloses the elements of claims 66 and 67 as noted above and furthermore discloses combining a rating based on the computed correlations and a rating based on the quality metric determined for each candidate search term [Barney, col 5, lines 20-35, Ryan Surfer keyword list col 8, lines 15-20]

Claim 70 and 84:

The combination of Ryan and Barney discloses the elements of claims 66-68 as noted above and furthermore, Ryan discloses sorting the candidate search terms according to a quality metric and adding the set of potential search terms only candidate search terms having a quality metric exceeding a threshold [key-word suggester, col 8, line 28]

Claim 71:

The combination of Ryan and Barney discloses the elements of claims 66 as noted above and furthermore, Ryan discloses receiving data from one or more pages of the website and examining text from the one or more pages for candidate search terms [Crawler key-word list, col 7, line 63-col 8, line 5]

Claim 73:

The combination of Ryan and Barney discloses the elements of claims 66 and 71 as noted above and furthermore, Ryan discloses receiving a website URL comprises receiving the advertiser's URL as the web site URL [col 6, lines 35-30]

Claim 74:

The combination of Ryan and Barney discloses the elements of claims 66 and 71 as noted above and furthermore, Ryan discloses receiving the website from the advertiser [col 6, lines 35-30].

Claim 75:

The combination of Ryan discloses the elements of claim 66 as noted above and furthermore, discloses assigning ratings to search terms and computing a correlation between the advertiser and one or more of the other advertisers using the assigned ratings of advertiser search terms [Barney, [col 5, lines 20-35].

Claim 76:

The combination of Ryan and Barney discloses the elements of claims 66 and 75 as noted above and furthermore, Ryan discloses predicting a likelihood that a search term will be relevant to the advertiser [col 8, lines 25-30]

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Claim 77:

The combination of Ryan and Barney discloses the elements of claims 66, 75 and 76 as noted above and furthermore, Ryan discloses determining a quality metric for potential search terms and predicting relevance of the potential search terms based on the quality metric [Surfer keyword list col 8, lines 15-20]

Claim 78:

The combination of Ryan and Barney discloses the elements of claim 66 as noted above and furthermore, Ryan discloses wherein presenting the sorted potential search terms to the new information provider comprises sending the sorted potential search terms with a web page to the output device [Fig 1A, 38]

Claims 67, 72-74 and 80-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ryan and Barney and further in view of US Pat No 6,078,916 to Culliss (hereafter Culliss).

Claim 72:

The combination of Ryan and Barney discloses the elements of claims 66 and 71 as noted above and furthermore, Ryan discloses examining substantially all text from the one or more pages but does not disclose examining meta tags from the one or more pages. Culliss discloses examining meta tags from the one or more pages [col 5, lines 15-20]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Ryan and Barney to include examining meta tags from the one or more pages as taught by Culliss for the purpose of attaching scores to each article.

Response to Arguments

Applicant's arguments filed 4/27/2006 with respect to claims 66-84 have been considered but are not persuasive for the reasons given below.

Applicant Argues:

Applicant states in the fourth paragraph on page 8 the following:
For example, claim 66 recites "obtaining a set of potential search terms for acceptance by a new information provider who is adding items to the database"

Examiner Responds:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that a "new information provider" is not described in the specification such that the claim language can be interpreted in light of the specification. Furthermore, it is noted that limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

MPEP Section 2106 requires Office personnel to give claims their broadest reasonable interpretation in light of the supporting disclosure. In *re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). As pointed out above, Applicant's specification fails to support the claim limitation "new information provider" and thus examiner is unable to interpret the claim limitation in light of the supporting disclosure.

Ryan discloses in column 1, lines 5-10 the following:
The present invention relates to a method and apparatus that allows for enhanced database searching, and more particularly, for use as an internet search engine.

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Regarding a search engine, a dictionary definition¹ is:

On the Internet, a program that searches for keywords I files and documents found on the World Wide Web, newsgroups, Gopher menus, and FTP archives,. Some search engines are used for a single Internet Site, such ad a dedicated search engine for a Web site. Others search across many sites, using such agents as spiders to gather lists of available files and documents and store these lists in databases that users can search by keyword.

Examiner concludes, based on the above that the search engine disclosed by Ryan reads on the claim limitation “new information provider.”

Applicant Argues:

Applicant states in the fourth paragraph of page 8 the following:

Further, as another example, claim 66 recites “presenting to the new information provider on an output device the sorted potential search terms.”

Examiner Responds:

Examiner is not persuaded. The disclosure of Ryan reads on the above limitation as evidenced by the following:

- (1) The abstract includes providing results to the user.
- (2) Fig 1A, Display Content (38)
- (3) Column 30, lines 42-55.

Applicant Argues:

Applicant states in the first paragraph on page 9 the following:

¹ Microsoft Computer Dictionary, Fifth Edition

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However, Barney does not show or suggest “computing correlations between the potential search terms for the new information provider and search terms of other information providers stored in the database” as recited in claim 66. First, Barney is not related to potential search terms of a new information provider. Second, in the limitation of claim 66, relevant information is stored in a database and the correlations are compared on data stored in the database. Barney teaches crawling others’ web sites and performing correlations on the crawled data.

Examiner Responds:

Examiner is not persuaded. The following extract from the MPEP is relevant:

2141.01(a) [R-3] Analogous and Nonanalogous Art

>I. < TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE
ANALOGOUS PRIOR ART

The examiner must determine what is “analogous prior art” for the purpose of analyzing the obviousness of the subject matter at issue. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Examiner maintains that Barney is reasonable pertinent to the particular problem with which the inventor was concerned because both Barney and Applicant use the Pearson Correlation formula to measure the correlation between search terms.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday, 8:00 am and 4:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

6/29/2006



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